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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/354,018	07/15/1999	STEPHEN P. MORSE	013.0077	4485
7590	11/18/2003		EXAMINER	
ERIK B CHEDAK STEPTOE & JOHNSON LLP 1330 CONNECTICUT AVENUE N.W. WASHINGTON, DC 20036			HUYNH, CONG LAC T	
			ART UNIT	PAPER NUMBER
			2178	
DATE MAILED: 11/18/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/354,018	MORSE, STEPHEN P.
Examiner	Art Unit	
Cong-Lac Huynh	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 20 August 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-4, 7, 8, 11, 12, 15, 16, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-4, 7-8, 11-12, 15-16, 19-20 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. This action is responsive to communications: amendment filed 8/20/03 to the application filed on 7/15/99.
2. Claims 5-6, 9-10, 13-14, 17-18 are canceled.
3. Claims 19-20 are added.
4. Claims 1-4, 7-8, 11-12, 15-16, 19-20 are pending in the case. Claims 1, 7, 11, 15, 19, 20 are independent claims.
5. The objection of the abstract remains since there is no new abstract submitted.
6. The rejections of claims 5-6, 9-10, 13-14, 17-18 under 35 U.S.C. 102 have been withdrawn in view of the cancellation of these claims.

Specification

7. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claims 1-4, 7-8, 11-12, 15-16 remain rejected under 35 U.S.C. 102(e) as being anticipated by Gupta et al. (US Pat No. 6,199,079 B1, 3/6/01, 3/20/98, priority 3/9/98).

Regarding independent claim 11, Gupta discloses:

- assessing a network site to receive a form including at least one field (col 2, line 66 to col 3, line 9; col 8, lines 15-25; col 9, lines 55-58)
- receiving a form from said network site, said form including at least one field to be filled in (col 2, line 66 to col 3, line 9; col 6, lines 28-39; col 8, lines 15-34)
- mapping said field to be filled in to a pre-determined value (col 2, line 66 to col 3, line 9; col 10, lines 19-24), said mapping step comprising mapping said field to a

schema (col 8, lines 28-45) mapping said schema to a value (col 8, lines 43-55) wherein said mapping step comprises the steps of mapping said at least one field to one of a uniform resource locator specific schema or a generic schema (figure 1D, #62, #64, col 6, lines 28-31, and col 8, lines 22-26: an appropriate form identifier for a particular vendor is determined based upon a selectable criterion using relationship 60 which associates the criterion of form URL 64 with a form identifier, form name 60 – the field of said particular form for said particular vendor, therefore, is also mapped to a URL specific schema as applied to the form; col 6, lines 40-55: the same user meta data can be specified in different ways by different forms to fill in a wide variety of forms by using the concatenation technique shows that this technique is generic schema, which can apply one rule to different forms)

Regarding claim 12, which is dependent on claim 11, Gupta discloses that said network site is a world wide web and said form is a hyper-text mark-up language form (col 2, line 66 to col 3, line 9: the *web pages*, written by hypertext markup language, *present the form for filling on the Internet*, therefore, said form is a hypertext markup language form and the network site is a world wide web; col 8, lines 30-34).

Independent claim 15 is for a system of method claim 11, and is rejected under the same rationale.

Regarding claim 16, which is dependent on claim 15, Gupta discloses that said form is a graphical user interface form (col 2, lines 66-67, col 8, lines 30-35 and col 4, lines 47-54: said on-line form is displayed on a user interface output device, therefore it is a graphical user interface form).

Claims 1-4, 7-8 are for a system and a network client of method claims 11-12, and are rejected under the same rationale.

10. Claims 19-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Gupta et al. (US Pat No. 6,199,079 B1, 3/6/01, 3/20/98, priority 3/9/98).

Regarding independent claim 20, Gupta discloses:

- accessing a network site to receive a form including at least one field to be filled in (col 2, line 66 to col 3, line 9; col 8, lines 15-25; col 9, lines 55-58)
- receiving the form from said network site (col 2, line 66 to col 3, line 9; col 6, lines 28-39; col 8, lines 15-34)
- associating a field name with each field to be filled in (col 2, line 66 to col 3, line 9; col 10, lines 19-24: mapping said field to be filled in to a pre-determined value)
- comparing the field name with a uniform resource locator specific field-to-schema mapping or a generic field-to-schema mapping to obtain a schema name which may be a dynamic schema name using an assumed field name (figure 1D, #60, #70, #90; col 6, lines 28-55 and col 8, lines 15-53: associating a form finding

criterion, a *form URL* 64 with the form name implies a comparison of the field name with the URL criterion form before associating the field name with the URL filed, and using the same metadata to map to different forms specified by different ways by using the concatenation technique shows the technique is generic schema, which can be applied to different forms)

- performing a schema-to-value mapping (col 8, lines 28-45: mapping said field to a schema; col 8, lines 43-55: mapping said schema to a value) and if no value is found by the mapping concatenating a value if a concatenating rule exists (col 6, lines 28-54)
- filling in the field with the value obtained in the previous step (col 8, lines 50-54)

Independent claim 19 is for a system of method claim 20, and is rejected under the same rationale.

Response to Arguments

11. Applicant's arguments filed 8/20/03 have been fully considered but they are not persuasive.

Applicants argue that Gupta does not anticipate the invention as amended.

Examiner respectfully disagrees.

The amendment is merely canceling some claims and including the canceled claims in the independent claims. Specially, claims 5-6, 9-10, 13-14, 17-18 are canceled and included in independent claims 1, 7, 11, 15 respectively. Therefore, there is no change since all old claims 1-18 are rejected under 102 rejections.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 703-305-0432. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9000.

clh
11/3/03



SANJIV SHAH
PRIMARY EXAMINER